REMARKS

Applicants submit these remarks in response to the Office Action dated November 29, 2004 ("Office Action"). Applicants have also filed a two-month Petition for Extension of time and believe that this extension of time is effective to allow timely filing of a response up to and including April 29, 2005. In the event that Applicants are incorrect in their assumption, please charge any fee due in connection with this submission to Deposit Account No.23-2415 referencing docket no. 30923-712.301. The above amendments and the following comments are submitted along with a Request for Continued Examination (RCE). Accordingly, entry of the amendments and consideration of the comments is proper and is respectfully requested.

Claims 3, 7, 8, 10, 12 and 23 have been amended in order to expedite prosecution of certain embodiments of the present invention. Claim 4 has been cancelled and the features thereof have been incorporated in Claims 3 and 23. Claims 7, 8, 10 and 12 have been revised by renumbering the sub-steps recited therein consistent with the revisions to Claim 3.

As all of the amendments are supported by the original disclosure and claims, no new matter has been added. The above amendments should not be construed as constituting any admission with respect to the patentability of the previously claimed subject matter, and Applicants reserve the right to pursue the canceled subject matter in one or more continuing patent applications.

The Claims Define Non-Obvious Subject Matter

Claims 3-23 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sadowski *et al.* "Assessing Similarity and Diversity of Combinatorial Libraries by Spatial Autocorrelation Function and Neural Networks," Angew. Chem. Int. Engl., Vol. 34 Issue 23/24 (1995), in view of Rooks "A Unified Framework for Visual Interactive Simulations," ACM Proceedings of the 1991 Winter Simulation Conference, pp 1146-1155 (1991). This rejection is traversed for at least the following reasons.

Present Claim 3 is directed to a method for graphically interfacing between a computer system and a user, wherein the computer system interactively displays objects representative of chemical compounds, wherein distances between the objects represent dissimilarity between the

corresponding chemical compounds. The interactivity of the method recited in Claim 3 allows for user input relating to one or more of the following: (i) deleting one or more of the objects from the window; (ii) adding one or more additional objects to the window; (iii) displaying chemical compound information associated with one or more of the objects; (iv) selecting between having the computer system evaluate the dissimilarities or retrieve dissimilarity values from a source; (v) selecting one or more dissimilarity evaluation techniques; (vi) selecting one or more properties to be evaluated as part of a dissimilarity evaluation; and (vii) selecting a scaling factor for one or more of the properties.

Sadowski *et al.* does not suggest each feature of Claim 3. For example, Sadowski *et al.* does not disclose a method for graphically interfacing between a computer system and a user, wherein the computer system interactively displays objects representative of chemical compounds, much less any of the (interactive) selecting features recited in Claim 3. It is acknowledged in the third paragraph on page 3 of the Office Action that "the method of Sadowski *et al.* is not illustrated with remaining graphical user input qualities including user input over display control, as recited in claim 3." The Office Action further relies on Rooks. However, for at least the reasons set forth below, Rooks fails to cure the deficiencies of Sadowski *et al.*

Rooks relates to the purported ambiguous terminology used in connection with visual interactive simulation (VIS). Rooks purports to outline general requirements of VIS systems to allow the development of a unified framework for VIS and provide an application-independent terminology which seeks to clarify and organize the concepts of VIS. (Abstract)

That the disclosure in Rooks is concerned with terminology and generalities relating to VIS is illustrated through out the document. In particular, the last paragraph on page 1146 of Rooks states the following:

> "This paper aims to encourage and facilitate dialogue between the various simulation communities, by refining the definitions of VIS and its components, and presenting them in a way which is illuminating to the researcher, instructive to the developer, and comprehensible to the user."

Specifically, the Office Action relies on the description of four general aspects advanced in Rooks as "requirements for a complete VIS system." (Pages 3 and 4 of the Office Action) However the recitations in the sections relied upon by the Office Action are nothing more than general descriptions of desirable requirements. Nothing in the sections of Rooks cited in the Office Action, or Rooks in its entirety provide guidance on how to practice the invention set forth in Claim 3 of the present application.

Assuming that Sadowski et al. and Rooks can be properly combined, there is no rationale or explanation in the Office Action on how such combination would allow one skilled in the art to arrive at the presently claimed invention. Rooks provides no guidance whatsoever on how to modify the method of Sadowski *et al.* to allow, for example, selecting between having the computer system evaluate the dissimilarities or retrieve dissimilarity values from a source; selecting one or more dissimilarity evaluation techniques; selecting one or more properties to be evaluated as part of a dissimilarity evaluation; or selecting a scaling factor for one or more of the properties.

The general requirements set forth in Rooks and relied upon in the Office Action are simply desirable features offered by the author as general requirements for a complete VIS system. At best, the disclosure in Rooks might be construed as an invitation to try and implement interactive features in VIS systems. But even so, without the benefit of Applicants' disclosure, there is no indication that based on Rooks alone one of skill in the art would have succeeded in imparting the interactivity and selectivity features of the present invention to the projection methods disclosed in Sadowski *et al.*

"Obvious to try" is not an appropriate standard and does not satisfy the requirements for establishing a *prima facie* case of obviousness. It is not enough if the prior art "piques the scientist's curiosity" because "obvious to try" is not the legal test. *In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed.Cir.1990) (citing *In re O'Farrell*, 853 F.2d 894 (Fed.Cir.1988)). An obvious to try situation exists when "further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *Id.* Here, much investigation would have been necessary for a successful leap form the general requirements

described in Rooks to arrive at the specific selectivity and interactivity features of the presently claimed invention. Rooks is completely lacking in enabling disclosure that would provide the requisite guidance to practice the presently claimed invention.

Accordingly, the Sadowski *et al.* reference, taken alone or in combination with Rooks does not render obvious any of the present claims. Thus, withdrawal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

CONCLUSION

Applicants believe that for the reasons set forth above, claims 3 and 5-23 are in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2337.

Respectfully submitted,

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